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Commissioner of Patents
Washington, D.C. 20231

Supervisory Examiner Wynn Coggins
Art Unit: 3625

Re. Application No. **09/543,764**
Examiner: James **Zurita**

December 3rd 2002

Dear Examiner Coggins,

Following on 34 sheets please find a copy of the reply made in the above identified application for patent including a Petition to Commissioner Under 37 CFR § 1.181 From Second Office Action' including:

A. Request for Reconsideration;
B. Repeated Action By Examiner;
C. Evidence of Inadequate Supervision;
D. Abrogation of Right to Appeal;
E. Summary and Request for Allowance.

The Primary Examiner who signed off on the pertinent Office action is Jeffrey Smith but the last page of the action also states that you are the supervisory examiner. As you conducted the interview six months ago prior filing response to the first Office action in this application and the interview recently in another application before the same examiner, and are the supervisory examiner for the art unit, it was thought that you would be the appropriate recipient of an advance copy of this material.

Please do not hesitate to call me with any questions or comments; it is hoped that you can resolve both of these expedited cases in a timely manner.

Respectfully yours,

Peter Gibson, Reg. #34,605

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Application No. **09/543,764**
Art Unit: **3625**

Filed **April 5th 2000** with MPEP 708.02 VIII
Petition for Accelerated Examination

PETITION TO COMMISSIONER
Under 37 CFR § 1.181(c) From Second Office Action

A. Request For Reconsideration

Petitioner, applicant in the above identified application for patent, respectfully submits that a full and proper reply in accordance with 37 CFR § 1.111(b), including a proper request for reconsideration in accordance with 37 CFR § 1.111, has been filed in response to the second Office action.

B. Repeated Action By Examiner

1. Petitioner respectfully submits that the second Office action in the present application for patent:

a. was not made final;

b. comprises a repeated action by examiner;

c. fails to consider applicant's arguments presented in reply to the first Office action;

d. conveys a repetition of the same rejection under 35 U.S.C. §103(a) conveyed in the first Office action;

e. repeats improper use of hindsight of applicant's disclosure in reconstruction of the claimed invention.

2. Petitioner respectfully submits, in support of B.1.c. above, that examiner's only statements regarding applicant's arguments conveyed in the second Office action follow:

a. "Applicant's arguments with respect to amended claims 1-4, 6, 10, 16, 24 and 34 ... are moot in view of the new ground(s) of rejection";

b. "Applicant's arguments wtih respect to claims 7-9, 11-15, 17-23 and 25-33 have been fully considered but they are not persuasive" (SOA page 2).

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3. Petitioner respectfully submits, in support of B.1.d. above, that examiner failed to rely upon new grounds of rejection in repetition of action rejecting the sole base claim and all other claims except claims 29 - 34.

4. Petitioner respectfully submits that a new grounds of rejection is relied upon in the second Office action in the rejection of claims 29 - 34 and that this reference, *Colonial Restoration*, references the use of custom liquid coatings.

5. Petitioner respectfully submits, in support of B.1.d. above, that the only substantive difference between the §103(a) rejection conveyed in the second Office action and the first was the omission of a production line capable of producing custom color liquid coatings taken verbatim from present claim 1:

> 'a containerized liquid coating production line capable of producing a plurality of particular, [non-standard] custom, color containerized liquid coatings with a precision in the addition of colorant to liquid coating base superior to the precision readily obtainable by a conventional local retailer'; and

the use of a new reference, *Colonial Restoration*, referencing custom liquid coatings, in rejection of claims 29 - 34 only.

6. Petitioner respectfully submits that in neither the first nor second Office actions is there any indication that the prior art discloses, teaches, or suggests a production system capable of producing custom color liquid coatings.

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7. Petitioner respectfully submits, in support of B.1.e. above, that since a production system capable of producing custom color liquid coatings is unknown to the prior art improper use of hindsight of applicant's disclosure was necessarily employed in reconstructing the claimed invention as grounds for rejection under §103(a) because "(o)bviousness cannot be predicated on what is unknown" (Robert L. Harmon, *Patents and the Federal Circuit*, 2nd Edition, The Bureau of National Affairs Inc., Washington, D.C., 1991, page 92, in reference to *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989) and "(t)he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*" (MPEP 706.02(j)).

C. Evidence of Inadequate Supervision

1. Petitioner respectfully submits that the second Office action contains many errors, fifteen being identified in B. 1. - 15. of Applicant's Response, including errors indicating incomprehension of fundamental examining procedure:

a. confusion regarding amendment and citation of new grounds of rejection as grounds for permitting examiner to consider applicant's arguments moot: applicant amended only to overcome §112 rejections, examiner stated that applicant's arguments regarding these amended claims were rendered moot by the new grounds of rejection and stated only that applicant's arguments regarding the unamended claims were unpersuasive, without any statement regarding applicant's arguments regarding rejection under §103 of amended claims including base claim 1 thereby failing to address the most important arguments presented by Applicant;

b. failure to comprehend the necessity of basing obviousness rejections upon the prior art rather than reconstruction of the claimed invention from speculation concerning prior and known art as suggested by applicant's disclosure: examiner evidently believes that "(r)econstructions are based upon hindsight reasoning" and are proper if exclusive of "knowledge gleaned **only** from the applicant's disclosure", (SOA pages 3-4), "obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention" (SOA page 5);

c. failure to comprehend the necessity of considering what **would have been** obvious to one skilled in the art at the time of the invention as opposed to what **would be** obvious as revealed by use of the present tense: "in this case, **it is generally known**" (SOA, bottom page 5); "**It is well known**" (SOA, top page 6);

d. failure to comprehend the mechanics of an obviousness rejection: examiner argues that one skilled in the art would have been motivated to disclose a claimed limitation for some 'obvious reason' without any argument that a claimed limitation would have been obvious in view of combined teachings by the prior art: "it would have been obvious to one skilled in the art ... to combine the teachings ... and disclose ... for the obvious reason that liquid coatings are" (SOA, page 18, last par.); "(o)ne of ordinary skill in the art would have been motivated to include ... for the obvious reason that these are normal considerations" (SOA, page 22, last par.).

D. Abrogation of Right to Appeal

Petitioner respectfully submits that since the rejection under 35 U.S.C. 103(a) conveyed in the first Office action is repeated in a second Office action which was not made

final Applicant's right to appeal has been abrogated:

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement (MPEP 706.07(a);

and since the second Office action was not made final and the only 'new' ground of rejection, *Colonial Restoration*, was relied upon in rejection only for claims 29 - 34, no new grounds of rejection were utilized in repetition of rejection under 35 U.S.C. 103(a) of claims 1 - 4 and 6 - 28.

E. Summary and Request for Allowance

1. Petitioner respectfully submits that the filing of Amendment A in accordance with the agreement reached in personal interview on April 3rd 2002 overcame all §112 objections and rejections but examiner has refused to recognize this.

2. Petitioner respectfully submits that the second Office action is a repetition of the first with the same grounds employed in rejection of present claims 1 - 4 and 6 - 28.

3. Petitioner respectfully submits that the second Office action demonstrates a failure in supervision because of numerous errors and failure of examiner to observe basic principles of rejection under 35 U.S.C. 103(a), the effect of entered amendments, and the need to address all arguments presented by applicant in reply to rejection.

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4. Petitioner respectfully submits that applicant's response to the first Office action overcame all the grounds of rejection conveyed thereby, that applicant's response to the second Office action overcomes all the grounds of rejection conveyed thereby, that both said responses clearly point out, in the language of the claims, distinctions patentably distinguishing the presently claimed invention over the prior art, and that the present application is in full and proper condition for allowance which action is further respectfully and humbly requested.

Respectfully,

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